

REMARKS

The subject application includes claims 72-248 pending and under consideration. An Office Communication mailed on December 16, 2005 indicated that the previous Response filed by the Applicant on September 21, 2005 was not fully responsive for the following reasons:

“The reply must present arguments pointing out specific distinctions believed to render the claims, including any *newly* presented claims (newly added claims 136-248), and where support for the amendments is found in the specification and how they are patentable over any applied references” (emphasis in original).

Citations to MPEP §§ 714.02 and 2163.06 and 37 CFR §1.111 were made in reference to the quoted language. The Applicant has reviewed and considered the Office Communication and submits the following in response to the same. Accordingly, reconsideration and allowance of the subject application are hereby requested.

With regard to presenting arguments pointing out specific distinction believed to render the claims patentable over any applied references, please consider the following. In a first Office Action dated August 11, 2004, claims 72, 91 and 111 were rejected under 35 USC §102(e) as being anticipated by U.S. Patent No. 6,371,988 to Pafford et al. (“the ‘988 patent”). The ‘988 patent was the only reference applied against the pending claims. In the Applicant’s Response filed with the U.S. Patent and Trademark Office on December 13, 2004, the Applicant presented arguments pointing out specific distinctions believed to render claims 72, 91 and 111 patentable over each of the applied references (i.e., the ‘988 patent).

In a second Office Action dated March 14, 2005, claims 72, 91 and 111 were again rejected under 35 USC §102(e) as being anticipated by the ‘988 patent. Once again, the ‘988 patent was the only references applied against the pending claims. In the Applicant’s Response filed with the U.S. Patent and Trademark Office on September 14, 2005, the Applicant presented further arguments pointing out specific distinctions believed to render claims 72, 91 and 111 (as well as new claim 134) patentable over all applied references (i.e., the ‘988 patent). The Applicant also submitted a new claim 135, and presented comments and arguments in support of the patentability of new claim 135 over the ‘988 patent.

On September 21, 2005, the Applicant filed an Amendment with the U.S. Patent and Trademark Office wherein new claims 136-248 were added to the subject application. As pointed out in Applicant's Amendment, new claims 136-248 were copied from U.S. Patent Application No. 10/112,745 to Michelson (U.S. Patent Application Publication No. 2002/0161442) to preserve the Applicant's right to provoke an interference under 35 U.S.C. §135.

Patentability of the Newly Presented Claims 136-248

With regard to presenting arguments pointing out specific distinction believed to render the new claims 136-248 patentable over any of the applied references, please consider the following.

Patentability of New Claims 136-155 and 229-232

New independent claim 136 recites language very similar to that recited in previously presented independent claim 72, with the exception of the replacement of "said interior side forming a corner with said generally straight portion of said leading end" (claim 72, lines 17-18) with "a portion of said exterior side being in a plane generally parallel to the mid-longitudinal axis, said portion of said exterior side intersecting said generally straight portion of said leading end and forming a corner with said generally straight portion of said leading end" (claim 136, lines 17-20), and the additional recitation of "said trailing end being adapted to conform from side to side to at least a portion of the peripheral contour of at last one of the anterior and posterior aspects of the vertebral bodies adjacent a disc space into which said implant is inserted" (claim 136, lines 22-24).

The Applicant submits that new independent claim 136 is patentable over the '988 patent (the only applied reference) for at least those reasons set forth in Applicant's Responses filed with the U.S. Patent and Trademark Office on December 13, 2004 and September 14, 2005 in support of the patentability of previously presented claim 72. Furthermore, the Applicant submits that the '988 patent fails to disclose an implant having a portion of an exterior side that is in a plane generally parallel to a mid-longitudinal axis and intersecting a generally straight portion of a leading end to form a corner, and a trailing end

adapted to conform from side to side to at least a portion of the peripheral contour of at least one of the anterior and posterior aspects of the vertebral bodies adjacent a disc space into which the implant is inserted, as recited in new independent claim 136.

Claims 137-155 and 229-232 depend from independent claim 136 and are submitted to be patentable for at least the reasons supporting the patentability of independent base claim 136. Additionally, the Applicant submits that new claims 137-155 and 229-232 are based in large part on previously presented claims 73-90, which have not been substantively rejected over any applied reference.

Patentability of New Claims 156-178 and 233-238

New independent claim 156 recites language similar to that recited in previously presented independent claim 72, with the exception of replacement of the preamble language of “for insertion at least in part into an implantation space formed across the height of a disc space between adjacent vertebral bodies of a human spine” (claim 72, lines 1-3) with “for insertion at least in part across the height of a disc space between adjacent vertebral bodies of a human spine” (claim 156, lines 1-3), replacement of the claim language of “said upper and lower portions being non-arcuate along at least a portion of the length of said implant ” (claim 72, lines 10-11) with “said upper and lower portions being non-arcuate from side to side” (claim 156, line 17), and replacement of the language in claim 72 of “said leading end having a generally straight portion from side to side, said interior side forming a corner with said generally straight portion of said leading end” (claim 72, lines 16-18) with “said leading end having a shape that is asymmetrical from side to side, said trailing end having a shape from side to side different than the shape of said leading end” (claim 156, line 14-15). Other relatively minor difference between new claim 156 and previously submitted claim 72 include replacement of “an interior facing side” with “an interior side”, replacement of “an exterior facing side” with “an exterior side”, and replacement of “approximately one-half of the width” with “one-half of the width”.

The Applicant submits that new independent claim 156 is patentable over the ‘988 patent (the only applied reference) for reasons similar to those set forth in Applicant’s Responses filed with the U.S. Patent and Trademark Office on December 13, 2004 and

September 14, 2005 in support of the patentability of previously presented claim 72. Furthermore, the Applicant submits that the '988 patent fails to disclose an implant having a leading end with a shape that is asymmetrical from side to side, and a trailing end having a shape from side to side different than the shape of the leading end, as recited in new independent claim 156.

Claims 157-178 and 233-238 depend from independent claim 156 and are submitted to be patentable for at least the reasons supporting the patentability of independent base claim 156. Additionally, the Applicant submits that new claims 157-178 and 233-238 are based in large part on previously presented claims 73-90, which have not been substantively rejected over any applied reference.

Patentability of New Claims 179-202 and 239-242

New independent claim 179 recites language very similar to that recited in previously presented independent claim 91, with the exception of replacement of the language "said interior side forming a corner with said generally straight portion of said leading end, said interior side adapted to be oriented toward an interior side of another implant when inserted within the disc space" (claim 91, lines 14-17) with "a portion of said exterior side being in a plane generally parallel to the mid-longitudinal axis, said portion of said exterior side intersecting said generally straight portion of said leading end and forming a corner with said generally straight portion of said leading end, said interior side adapted to be oriented toward an interior side of another implant when inserted within the disc space" and "said trailing end being adapted to conform from side to side to at least a portion of the peripheral contour of at least one of the anterior and posterior aspects of the vertebral bodies adjacent a disc space into which said implant is inserted" (claim 179, lines 15-23).

The Applicant submits that new independent claim 179 is patentable over the '988 patent (the only applied reference) for reasons similar to those set forth in Applicant's Responses filed with the U.S. Patent and Trademark Office on December 13, 2004 and September 14, 2005 in support of the patentability of previously presented claim 91. Furthermore, the Applicant submits that the '988 patent fails to disclose an implant having a portion of an exterior side that is in a plane generally parallel to a mid-longitudinal axis and

intersecting a generally straight portion of a leading end to form a corner, an interior side adapted to be oriented toward an interior side of another implant when inserted within the disc space, with the trailing end adapted to conform from side to side to at least a portion of the peripheral contour of at least one of the anterior and posterior aspects of the vertebral bodies adjacent a disc space into which the implant is inserted, as recited in new independent claim 179.

Claims 180-202 and 239-242 depend from independent claim 179 and are submitted to be patentable for at least the reasons supporting the patentability of independent base claim 179. Additionally, the Applicant submits that new claims 180-202 and 239-242 are based in large part on previously presented claims 92-110, which have not been substantively rejected over any applied reference.

Patentability of New Claims 203-228 and 243-248

New independent claim 203 recites language very similar to that recited in previously presented independent claim 111, with the exception of replacement of the language “said upper and lower portions being non-arcuate along at least a portion of the length of said implant” (claim 111, lines 12-13) with “said upper and lower portions being non-arcuate from side to side” (claim 203, line 20), and replacement of the language “said leading end being asymmetrical from side to side, said interior side adapted to be oriented toward an interior side of another implant when inserted within the disc space” (claim 111, lines 18-19) with “said leading end having a shape that is asymmetrical from side to side, said trailing end having a shape from side to side different than the shape of said leading end, said interior side adapted to be oriented toward an interior side of another implant when inserted within the disc space” (claim 203, lines 17-20).

The Applicant submits that new independent claim 203 is patentable over the ‘988 patent (the only applied reference) for reasons similar to those set forth in Applicant’s Responses filed with the U.S. Patent and Trademark Office on December 13, 2004 and September 14, 2005 in support of the patentability of previously presented claim 111. Furthermore, the Applicant submits that the ‘988 patent fails to disclose an implant having a leading end with a shape that is asymmetrical from side to side, and a trailing end having a

shape from side to side different than the shape of the leading end, as recited in new independent claim 203.

Claims 204-228 and 243-248 depend from independent claim 203 and are submitted to be patentable for at least the reasons supporting the patentability of independent base claim 203. Additionally, the Applicant submits that new claims 204-228 and 243-248 are based in large part on previously presented claims 112-133, which have not been substantively rejected over any applied reference.

Support For the Newly Presented Claims 136-248

With regard to the quoted language on page 2 of the Office Communication that “[t]he reply must present arguments pointing out . . . where support for the amendments is found in the specification” (emphasis in original), the Applicant could not locate the referenced language in any of the citations referred to in the Office Communication. (i.e., MPEP §§ 714.02 and 2163.06 and 37 CFR §1.111). If the requirement to provide support in the specification regarding each of the newly added claims is maintained, the Applicant respectfully requests clarification regarding where in the citations referred to in the Office Communication this requirement is set forth.

Nevertheless, the Applicant submits that the newly submitted claims 136-248 recite subject matter that is very similar to the subject matter recited in previously submitted claims 72-135. Specifically, as indicated above, new independent claims 136 and 156 recite language similar to that recited in previously presented independent claim 72, new independent claim 179 recites language similar to that recited in previously presented independent claim 91, and new independent claim 203 recites language very similar to that recited in previously presented independent claim 111. Additionally, the new dependent claims 137-155, 157-178, 180-202 and 204-248 depending from new independent claims 136, 156, 179 and 203 are similar to the previously presented claims depending from independent claims 72, 91 and 111.

Support for New Claims 136-155 and 229-232

As indicated above, new independent claim 136 recites language very similar to that recited in previously presented independent claim 72, with the exception of the replacement of “said interior side forming a corner with said generally straight portion of said leading end” (claim 72, lines 17-18) with “a portion of said exterior side being in a plane generally parallel to the mid-longitudinal axis, said portion of said exterior side intersecting said generally straight portion of said leading end and forming a corner with said generally straight portion of said leading end” (claim 136, lines 17-20), and the additional recitation of “said trailing end being adapted to conform from side to side to at least a portion of the peripheral contour of at last one of the anterior and posterior aspects of the vertebral bodies adjacent a disc space into which said implant is inserted” (claim 136, lines 22-24).

The above-cited features recited in independent claim 136 are illustrated, for example, in Figures 4, 5, 10, 12, 13, 16A-16D and 35, and are described in the corresponding portions of the specification. Additionally, side-by-side placement of implants is illustrated, for example, in Figures 6, 8 and 9, and is described in the corresponding portions of the specification. The Applicant also submits that new dependent claims 137-155 and 229-232 are based in large part on previously presented claims 73-90, which have not been substantively rejected over any applied reference.

Support for New Claims 156-178 and 233-238

As indicated above, new independent claim 156 recites language similar to that recited in previously presented independent claim 72, with the exception of replacement of the preamble language of “for insertion at least in part into an implantation space formed across the height of a disc space between adjacent vertebral bodies of a human spine” (claim 72, lines 1-3) with “for insertion at least in part across the height of a disc space between adjacent vertebral bodies of a human spine” (claim 156, lines 1-3), replacement of the claim language of “said upper and lower portions being non-arcuate along at least a portion of the length of said implant ” (claim 72, lines 10-11) with “said upper and lower portions being non-arcuate from side to side” (claim 156, line 17), and replacement of the language in claim 72 of “said leading end having a generally straight portion from side to side, said interior side forming a

corner with said generally straight portion of said leading end” (claim 72, lines 16-18) with “said leading end having a shape that is asymmetrical from side to side, said trailing end having a shape from side to side different than the shape of said leading end” (claim 156, line 14-15). Other relatively minor difference between new claim 156 and previously submitted claim 72 include replacement of “an interior facing side” with “an interior side”, replacement of “an exterior facing side” with “an exterior side”, and replacement of “approximately one-half of the width” with “one-half of the width”.

The above-cited features recited in independent claim 156 are illustrated, for example, in Figures 4, 5, 10, 12, 13, 16A-16D and 35, and are described in the corresponding portions of the specification. Additionally, side-by-side placement of implants is illustrated, for example, in Figures 6, 8 and 9, and is described in the corresponding portions of the specification. The Applicant also submits that new dependent claims 157-178 and 233-238 are based in large part on previously presented claims 73-90, which have not been substantively rejected over any applied reference.

Support for New Claims 179-202 and 239-242

As indicated above, new independent claim 179 recites language very similar to that recited in previously presented independent claim 91, with the exception of replacement of the language “said interior side forming a corner with said generally straight portion of said leading end, said interior side adapted to be oriented toward an interior side of another implant when inserted within the disc space” (claim 91, lines 14-17) with “a portion of said exterior side being in a plane generally parallel to the mid-longitudinal axis, said portion of said exterior side intersecting said generally straight portion of said leading end and forming a corner with said generally straight portion of said leading end, said interior side adapted to be oriented toward an interior side of another implant when inserted within the disc space” and “said trailing end being adapted to conform from side to side to at least a portion of the peripheral contour of at least one of the anterior and posterior aspects of the vertebral bodies adjacent a disc space into which said implant is inserted” (claim 179, lines 15-23).

The above-cited features recited in independent claim 179 are illustrated, for example, in Figures 4, 5, 10, 12, 13, 16A-16D and 35, and are described in the corresponding portions

of the specification. Additionally, side-by-side placement of implants is illustrated, for example, in Figures 6, 8 and 9, and is described in the corresponding portions of the specification. The Applicant also submits that new dependent claims 180-202 and 239-242 are based in large part on previously presented claims 92-110, which have not been substantively rejected over any applied reference.

Support for New Claims 203-228 and 243-248

As indicated above, new independent claim 203 recites language very similar to that recited in previously presented independent claim 111, with the exception of replacement of the language “said upper and lower portions being non-arcuate along at least a portion of the length of said implant” (claim 111, lines 12-13) with “said upper and lower portions being non-arcuate from side to side” (claim 203, line 20), and replacement of the language “said leading end being asymmetrical from side to side, said interior side adapted to be oriented toward an interior side of another implant when inserted within the disc space” (claim 111, lines 18-19) with “said leading end having a shape that is asymmetrical from side to side, said trailing end having a shape from side to side different than the shape of said leading end, said interior side adapted to be oriented toward an interior side of another implant when inserted within the disc space” (claim 203, lines 17-20).

The above-cited features recited in independent claim 203 are illustrated, for example, in Figures 4, 5, 10, 12, 13, 16A-16D and 35, and are described in the corresponding portions of the specification. Additionally, side-by-side placement of implants is illustrated, for example, in Figures 6, 8 and 9, and is described in the corresponding portions of the specification. The Applicant also submits that new dependent claims 204-228 and 243-248 are based in large part on previously presented claims 112-133, which have not been substantively rejected over any applied reference.

CONCLUSION

In view of the foregoing remarks, it is respectfully submitted that Applicant's application is now in condition for allowance with pending claims 72-248.

Reconsideration of the subject application is respectfully requested. Timely action towards a Notice of Allowability is hereby solicited. The Examiner is encouraged to contact the undersigned by telephone to resolve any outstanding matters concerning the subject application.

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